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09/923,311	08/07/2001	Khai Hee Kwan		1856

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EXAMINER

BASHORE, ALAIN L

ART UNIT PAPER NUMBER

1762

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/923,311

Applicant(s)

KWAN, KHAI HEE

Examiner

Alain L. Bashore

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 16 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 16 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Previous office action re-Issued***

1. The previous office action is re-issued with further explanation of the office's position regarding pending claims.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 16, 24-30 drawn to process, classified in class 705, subclass 44.
- II. Claims 18-23 drawn to apparatus, classified in class 705, subclass 44.

3. Newly submitted claims 18-23 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I and II are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the system may be used to provide a payment other than that using utility accounts.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The newly added negative limitation ""wherein said utility account is not a mobile phone account" is considered new matter. The negative limitation was not originally disclosed in applicant's specification, and therefore will not be further considered regarding the rejection of record.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6, 16, 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill, Jr. in view of Mousseau et al.

Morrill, Jr. discloses a computer method for paying for goods and services over a network using utility accounts with at least one utility service provider, a client terminal, a merchant server and a wireless communications device (col 1, lines 18-24). There is provided a centralized payment processor linked to the network, and sub-accounts established on the provider's main processor (col 4, lines 16-24). Password identification, approval codes, and authentication steps are included (col 4, lines 25-30). After authentication, a debit is recorded to the payer's payment amount in the monthly utility bill, subject to adjustment. Internet use is disclosed (col 4, lines 31-38).

Morrill, Jr. does not explicitly disclose a verification of purchase including the step of downloading a text message that is received and matched against a retrieved copy.

Mousseau et al discloses verification including the step of downloading a text message which is received and matched against a retrieved copy (para 0171 and cl 7).

It would have been obvious to one with ordinary skill in the art to include a verification of purchase including the step of downloading a text message which is received and matched against a retrieved copy because Moussaue et al teaches the importance of synconization for wireless device communications (para 0007).

### ***Response to Amendment***

11. The paper entitled "declaration" under 37 CFR 1.132 filed 1-24-05 is insufficient to overcome the rejection of claims based upon 35 U.S.C 103 as set forth in the last Office action because: there is no argument or evidence set forth.

***Response to Arguments***

12. Applicant's arguments filed have been fully considered but they are not persuasive.

Regarding the restriction made of record, the intended use as recited in the apparatus claims does not limit the apparatus from being utilized for other types of methods. The claimed structures in the method claims do not preclude non-utility accounts. It is assumed that U.S. restriction practice is applicable in this case.

As per claims 5-6, there is disclosed in the primary reference the use of Internet and interface with other network (col 10, lines 60-67; col 11, lines 1-10).

A negative limitation in the claims requires a showing in the specification as to the exact disclosure. A "reading of the specification in totality" is insufficient.

As explained in MPEP 608.01(n): The fact that independent and dependant claims are of different statutory classes does not, in itself, render the latter improper. The test as to whether a claim is a proper dependant claim is that it shall include every limitation of the claim from which it depends (35 U.S.C 112, fourth paragraph), or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. Regarding the example at hand, since the apparatus may perform other methods it is not a proper dependant claim. Since the apparatus claims have been withdraw from consideration, they have not been objected to as being improper.

While the specification describes a "utility provider", there is no definition of what is a "utility". For the purposes of the examination a utility is any provider of a good and /

or service provided to the public. The prior art describes tolls, which meets the broad definition of utility.

The request regarding use of the Internet for prosecution is noted. It is not group policy to use the Internet for such at this time. The MPEP does not require the use thereof. Applicant may use a "certificate of mailing" for delays.

### ***Conclusion***

**13.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.




14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Regarding all Class 705 applications, the management contact regarding examination is: Vincent Millin (SPE, art unit 3624) at 571-272-6747.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Alain L. Bashore  
Primary Examiner  
Art Unit 1762